



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/509,319

09/27/2004

Martin Roth

75248-034

1908

21890

7590

02/26/2008

PROSKAUER ROSE LLP
PATENT DEPARTMENT
1585 BROADWAY
NEW YORK, NY 10036-8299

EXAMINER

KRUER, KEVIN R

ART UNIT

PAPER NUMBER

1794

MAIL DATE

DELIVERY MODE

02/26/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/509,319	Applicant(s) ROTH ET AL.	
	Examiner KEVIN R. KRUER	Art Unit 1794	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 7/29/07.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) 9-16 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

1. Claims 9-16 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on May 26, 2006.
2. Applicant's election with traverse of group I in the reply filed on May 26, 2006 is acknowledged. The traversal is on the ground(s) that the search would not be an undue burden. This is not found persuasive because the inventions are classified in different classes and each invention requires a distinct set of classes/subclasses to be searched.

The requirement is still deemed proper and is therefore made FINAL.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hoffmann et al (US 4,806,450) in view of Kawase et al (US 5,753,362).

Hoffmann teaches a coating composition comprising a (meth)acrylic copolymer having a molecular weight of 15,000-500,000 (col 3, lines 37+) and an OH value of 20-100mg KOH/g (col 3, line 10). The copolymer comprises (meth)acrylic acid, (meth)acrylate, and hydroxylalkyl (meth)acrylate, wherein some of the carboxyl groups

Art Unit: 1794

of the copolymer are esterified by reaction with glycidyl (meth)acrylate (abstract), preferably 10-60% (col 3, line 6). The copolymer comprises 8-30wt% acrylic acid (abstract).

Hoffmann does not teach that the reaction product should further comprise an unsubstituted phenol such that the phenol to (meth)acrylic ester ratio is within the claimed range. However, Kawase teaches a methacrylic acid copolymer may have its glass transition temperature optimized by utilizing a phenol methacrylate such as benzyl methacrylate (col 13, lines 18+). Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to polymerize benzyl methacrylate into the polymer taught in Hoffman in the claimed relative amounts in order to optimize the glass transition temperature of the coating.

With regards to claim 8, it is known that the molecular weight of a polymer affects its processability. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to optimize the molecular weight of the polymer taught in Awokola in order to optimize the processability of the composition.

Response to Arguments

Applicant's arguments filed 7/29/07 have been fully considered but are not persuasive.

Applicant argues that there is no teaching or suggestion in the cited publications to make the proposed combination and arrive at the presently claimed invention. Specifically, applicant argues there is no mention made of the glass transition temperature of the composition of Hoffmann. The examiner respectfully

Art Unit: 1794

disagrees. Hoffmann teaches the film is preferably solid at room temperature (col 7, lines 55+). Furthermore, the skilled artisan would have known that it is desirable to control the glass transition temperature of a film in order for said film to be easily processable and useful for its intended use.

Applicant further argues the Kawase teaches the use of various polymers, not just benzyl (meth)acrylate may be polymerized into a copolymer for the purpose of raising the glass transition temperature. Said argument is noted but is not persuasive. The standard for obviousness is not whether the proposed modification is the sole possible modification taught by the prior art but whether the skilled artisan, given the teachings of the prior art, would have been motivated to make the proposed combination. In the present application, the examiner maintains the use of benzyl (meth)acrylate would have been obvious for reasons of record.

Applicant argues the skilled artisan would have no reasonable expectation that the influence of benzyl (meth)acrylate has on the glass transition temperature in the matrix of Kawase would be the same in the different matrix of Hoffmann. Said argument is not persuasive because the effect of monomer selection and mount on glass transition temperature is well established in the art. Furthermore, applicant has provided no argument/evidence supporting the conclusion that benzyl methacrylate would be expected to perform differently in the two matrixes.

For the reasons noted above, the rejections are maintained.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to KEVIN R. KRUEER whose telephone number is (571)272-1510. The examiner can normally be reached on Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rena Dye can be reached on 571-272-3186. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 1794

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Kevin R Kruer/
Primary Examiner, Art Unit 1794

<div>Application Number</div> <div></div>	Application/Control No.	Applicant(s)/Patent under Reexamination	
	10/509,319	ROTH ET AL.	
	Examiner	Art Unit	
	KEVIN R. KRUER	1794	